

REMARKS

In the Office Action, claims 1-14, 23-28 and 41-58 were rejected. Applicants would like to thank the Examiner for noting the allowable subject matter of the claims 46-50. By the present Response, claims 1, 5, 6, 25 and 54 are amended. Additionally, claims 3, 4, 22, 41, 46 and 51 are canceled without prejudice. Upon entry of the amendments, claims 1, 2, 5-14, 23, 24, 26-28, 41-53 and 55-58 will remain pending in the present patent application. Reconsideration and allowance of all pending claims are requested.

Objections to the Drawings

The Examiner objected to the drawings because of a certain informality on page 23, line 6, which referred to "service center telephone directory button 218" in reference to Figure 8. The Examiner has graciously pointed to the fact that Figure 8 contains no such reference number and that the reference numeral 218 is used elsewhere to indicate the "systems reports page" of Figure 9. Accordingly, Applicants have amended the specification to delete the use of reference numeral "218" on page 23, line 6 of the specification. Applicants believe that entry of this amendment overcomes the Examiner's objection to the specification. Thus, Applicants respectfully request withdrawal of the objection.

Double Patenting Objections

In the office action, the Examiner rejected a number of claims based on the judicially created doctrine of obviousness-type double patenting. Applicants address each of these rejections in turn below.

Claims 46-50

In the Office Action, the Examiner rejected claims 46-50 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,272,469. Specifically, the Examiner stated that, "[a] though the

conflicting claims are not identical, they are not patentably distinct from each other because claim 46 of the instant application recites, in essence, a system for carrying out the method of claim 1 of the '469 patent." See Paper 3, page 3. The Examiner further stated that, "[l]ikewise, claims 48-50 of the instant application are parallel to claims 2-4, respectively, of the '469 patent." See *id.* However, in light of the amendments to claim 46 by the present Response, Applicants respectfully assert that claims 46-50 are patentably distinct from the claims of the '469 patent. As pending, claim 46 recites, "a license module for verifying a subscription status." Claims 1-4 of the '469 patent do not recite or make obvious this feature. Moreover, claims 1-4 each recite, "first and second protocols, each protocol including machine executable instructions for controlling operation of a medical diagnostic system." These limitations are not recited in claims 46-50 of the instant application. In light of these recitations, it is clear that claims 46-50 are patentably distinct from claims 1-4 of the '469 patent. Accordingly, Applicants respectfully assert independent claim 46 and its respective dependent claims 47-50 are patentable and in condition for allowance. Reconsideration and allowance are respectfully requested.

Claims 1-14

In the Office Action, the Examiner provisionally rejected claims 1-14 under the judicially created doctrine of obviousness-double patenting as being unpatentable over claims 59-64 and 67 of co-pending application No. 09/476,708. However, in light of amendments to co-pending application No. 09/476,708 as well as the amendments to claims 1-14 of the instant application, Applicants respectfully assert that claims 1-14 of the instant application are patentably distinct from those of the co-pending application.

In a response entitled, "AMENDMENT AND RESPONSE TO OFFICE ACTION MAILED JULY 26, 2002" Applicants amended claim 59 of the referenced application. Specifically, Applicants amended claim 59 to recite, "wherein the user viewable indicia include an exemplary image obtainable via the protocol." The instant claim, namely

independent claim 1 of the instant application, does not recite this limitation. Moreover, presently pending independent claim 1 recites, "verifying a subscription status for the diagnostic location." Keeping these variations between the recited features of the two applications in mind, Applicants respectfully assert that these sets of claims are patentably distinct. Moreover, the cancellation of claims 3 and 4 of the instant application (pertaining to indicia regarding an exemplary image obtainable via the protocol), further buttresses the fact that the claims of co-pending application 09/476,708 and the instant claims, claims 1 through 14 of the present application, are patentably distinct from one another. Accordingly, Applicants respectfully request that the obviousness-type double patenting rejection be withdrawn.

Claims 41-45

In the Office Action, the Examiner provisionally rejected claims 41-45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 69-72 of co-pending application No. 09/476,708. Applicants, however, respectfully note that within the prosecution of the co-pending application, Applicants have amended claim 69 of that application. Specifically, within, "AMENDMENT AND RESPONSE TO OFFICE ACTION MAILED JULY 26, 2002" Applicants amended claim 69 to recite, "wherein the protocol list includes an exemplary image obtainable via the protocol." The instant claims, namely claims 41-45 of the instant application, do not recite this feature. Moreover, within the present Response, claim 41 has been amended to recite, "verifying a subscription status for access to the protocol." In light of the amendments to claim 69 of the co-pending application and claim 41 of the instant application, Applicants respectfully assert that these claims are, in fact, patentably distinct from one another. Accordingly, Applicants respectfully assert that claim 41 and its respective dependent claims 42-45 are patentable over claim 69-72 of co-pending application 09/476,708. Withdrawal of the rejection is respectfully requested.

Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1, 10 and 11 under 35 U.S.C. § 102(e) as being anticipated by Wood et al. (U.S. Patent No. 5,891,035). Applicants respectfully assert that the claims, as pending, are patentable over the cited reference.

A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985). Applicants respectfully assert that the instant claims recite features not disclosed in the cited reference.

For example, amended independent claim 1 recites, *inter alia*, “verifying a subscription status for the diagnostic location.” Subsequent to a thorough review of the cited reference, Applicants respectfully assert that the cited reference does not, in any way, disclose “verifying a subscription status for the diagnostic location” as recited in the instant claim. Accordingly, Applicants respectfully assert that independent claim 1 and its respective dependent claims 10 and 11 are patentable over the cited reference. Reconsideration and allowance are respectfully requested.

Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 2-9, 12-14, 23-28, 41-45 and 51-58 under 35 U.S.C. § 103(a) as being unpatentable over various references and assertions. Each of these rejections is addressed in turn.

As stated above, Applicants have amended independent claim 1 to recite “verifying a subscription status for the diagnostic location,” a feature similar to the feature recited in presently canceled claim 4. Moreover, independent claim 23, 41, 46 and 51 have also been amended to recite similar features. For example, these claims recite as follows:

Claim 23: "verifying a subscription status thereby allowing access to the protocol";

Claim 41: "verifying a subscription status for access to a protocol";

Claim 46: "a license module for verifying a subscription status regarding the first and second protocols"; and

Claim 51: "verifying subscription status for access to the protocol".

With these amendments in mind, Applicants note that the Examiner rejected the subject matter of claim 4 by employing the disclosure of the Wyman (US Pat. No. 5,260,999) reference. Thus, in the interest of efficient prosecution, Applicants will not only address the Examiner's rejections with respect to the instant Office Action, but also address the possible application of the Wyman reference to these independent claims.

Additionally, Applicants respectfully note that the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must

suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Independent Claim 1 and the Claims that Depend Therefrom

In the Office Action, the Examiner rejected claims 2-9 and 12-14 under 35 U.S.C. § 103(a). Applicants note that each of these claims depend from independent claim 1. Moreover, Applicants again note that the Examiner rejected claim 4 as being unpatentable over Wood et al. in light of Wyman. Keeping these facts in mind, Applicants respectfully assert that claims 1-14 are patentable and in condition for allowance.

Cited References Fail to Disclose all of the Recited Features

As discussed above, a proper § 103 rejection requires that the cited reference combination discloses all of the features of a given claim. In the instant case, Applicants respectfully assert that amended independent claim 1 contains features not found in the Wood et al. reference nor in the combination of the Wyman and Wood et al. references.

Amended independent claim 1, recites, *inter alia*, “verifying the subscription status for the diagnostic location; and *loading* the protocol at the medical diagnostic location from the machine readable medium.” Clearly, as argued above, the Wood et al. reference does not disclose this feature.

Additionally, even if the Examiner employs the Wyman reference, this feature is not disclosed. As is clear from the recitation of the claim, this claim relates to verifying the subscription status “for the *diagnostic location*,” and, “*loading the protocol* at the *medical diagnostic location*.” In contrast to this, the cited reference relates to, “licensing of software executed *on* computer systems.” See ‘999 patent, column 1, lines 22-26.

Accordingly, the system of the cited reference communicates with a center and verifies that a license is in order. See *id.* Once the license is verified, the system allows the software *already on* the computer to be employed. Thus, the cited reference in no way suggests verifying the subscription status for a *diagnostic* location where *a protocol is to be loaded*. Indeed, the cited reference discusses use of the system therein with *spreadsheet* programs, the programs being already loaded on the operated computers. See *id.*, column 2, lines 35-52. The mere fact that the cited reference discloses a license verification system relating to, for example, spreadsheets, would not be sufficient disclosure regarding the verification of subscription status regarding the diagnostic location recited in the instant claims. Moreover, as discussed above, there is no reason to believe the Wood et al. reference obviates this deficiency. Accordingly, Applicants respectfully assert that the Wood et al. reference in conjunction with the Wyman reference does not disclose all of the features recited in the instant claims.

Focusing on the dependent claims 2-9 and 12-14, Applicants respectfully assert that these claims are patentable not only for their dependence on an allowable base claim but also by virtue of the additional features recited therein. For example, in the Office Action, the Examiner rejected claims 2, 6-9 and 12 in light of Wood et al. and Official Notice. Applicants, in accordance with M.P.E.P. § 2144.03, respectfully object to the Examiner's use of Official Notice. Applicants request the Examiner, at a minimum, provide references to support his contention of regarding the features believed well-known and obvious. Additionally, the Examiner contends that a number of features recited in claims 3 and 14 are "obvious" without any references to support such a contention. Essentially, the Examiner has taken Official Notice regarding these features. Again, in accordance with M.P.E.P. § 2144.03, Applicants respectfully object and traverse the Examiner's use of Official Notice.

Lastly, the Examiner, with regards to claim 13, recites upon the Narayanaswami et al. (5,981,035) reference. Applicants respectfully assert that there is no reason to believe

the Narayanaswami et al. reference obviates the deficiencies of the Wood et al. and Wyman references discussed above. Accordingly, Applicants respectfully assert that claims 2-14 are patentable and in condition for allowance. Reconsideration and allowance are respectfully requested.

Cited References Lack the Motivation to Combine

Even assuming, *arguendo*, that the Examiner is able to present a reference combination that discloses all of the features of a claim, the Examiner must still present a convincing line of reasoning as to why the skilled artisan would combine the references to reach the rejected claim. In other words, the artisan, viewing only the collective teachings of the references, must find it obvious to selectively to pick and choose various elements and/or concepts from the cited references to arrive at the claimed invention. *See Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

The Federal Circuit has warned that the Examiner must not, "fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *See id.* When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). With regards to the rejection of claim 4 and the possible future rejection of amended claim 1, Applicants respectfully assert that the Examiner has employed this impermissible hindsight reconstruction to formulate the rejection.

Again, independent claim 1 relates to verifying the subscription status “for the *diagnostic location*,” and “*loading the protocol at the medical diagnostic location*.” In contrast to this, the cited reference relates to, “licensing of software executed *on* computer systems.” See ‘999 patent, column 1, lines 22-26. Accordingly, the system of the cited reference communicates with a center and verifies that a license is in order. See *id.* Once the license is verified, the system allows the software *already on* the computer to be employed. See *id.* Thus, the cited reference in no way suggests combination with a *medical* diagnostic location where *a protocol* is loaded. Indeed, the cited reference discusses use of the system therein with *spreadsheet* programs, the programs being already loaded on the operated computers. See *id.*, column 2, lines 35-52. The mere fact that the cited reference discloses a license verification system is not sufficient motivation to combine the Wood et al. reference with the Wyman reference to reach, “verifying the subscription status for the diagnostic location; and *loading the protocol at the medical diagnostic location from the machine readable medium*,” as recited in the instant claim. Clearly, the *loading of a protocol*, as defined in the instant application, on a *diagnostic location* is in no way equivalent to a *spreadsheet* application running on a computer.

Respectfully, Applicants assert the cited Examiner has employed impermissible hindsight to reach the instant claims. In other words, Applicants respectfully assert that the Examiner has reviewed the instant application and used the application as a roadmap to combine the Wood et al. reference with the Wyman reference. Again, Applicants respectfully assert that the Examiner, in the words of the Federal Circuit, must not “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” See *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). Accordingly, Applicants respectfully assert that independent claim 1 and its respective dependent claims 2-14 are patentable and in condition for allowance. Reconsideration and allowance are respectfully requested.

The Wyman Reference is Non-Analogous Art

Additionally, Applicants respectfully assert that the Wood et al. reference combination fails because Wyman is non-analogous prior art.

To support a valid § 103 rejection, the Examiner must also present appropriate references to support the rejection. Specifically, the Examiner must present “analogous” prior art. *See* M.P.E.P. §2141.01(a). To rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446; 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which deals, logically would have commended itself to an inventor’s attention considering his problem. *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858 26 U.S.P.Q.2d 1767 (Fed. Cir. 1993). Applicants respectfully assert that the Examiner has not satisfied the threshold burdens regarding the Wyman reference as applied to canceled dependent claim 4 and, assumably, amended independent claim 1.

Beginning with the first prong of the test, Applicants respectfully assert that the cited reference is not within the field of endeavor of the Applicants. As discussed above, the instant claims relate to *medical diagnostic systems* or to *medical diagnostic locations*. *See* Application, claims 1, 23, 41, 46 and 51. Indeed, again as discussed above, a system for checking the validity of licenses of regarding a *spreadsheet* could not be considered in the same field of endeavor as subscription verification in relation to protocol downloading on medical diagnostic systems.

Turning to the second prong of this test, then, Applicants respectfully assert that because of the matter with which the cited reference deals, it would *not* logically have commended itself to one skilled in the art considering the problem addressed by the

claimed invention. As stated above, the cited reference relates to the “managing [of] ...licensing software executed *on* computer systems.” See ‘999 patent, column 1, lines 22-26. In other words, the cited reference calls a center to determine whether the software *already loaded* on the computer is properly licensed. For example, the system may check to determine whether certain sections of a spreadsheet program are properly licensed to certain computers operating the software. See *id.*, column 2, lines 35-52. Clearly, the management of licenses regarding a spreadsheet, for example, is not logically related to the problem of maintaining up-to-date operational protocols for medical diagnostic systems.

Based on the foregoing, Applicants respectfully assert that the Wyman reference in non-analogous art and, as such, is improper in the proposed combination. Thus, Applicants assert that independent claim 1 and its respective dependent claims 2-14 are patentable and in condition for allowance. Reconsideration and allowance are respectfully requested.

Amended Claim 23 and the Claims Depending Therefrom

As stated above, claim 23 has been amended to recite, “verifying a subscription status thereby allowing access to the protocol.” Applicants respectfully assert that this feature is not recited in the Wood et al. reference. Moreover, Applicants respectfully assert that even if the Wyman reference could be combined with the Wood et al. reference, the instant recited feature is not reached. As stated above, a licensing check regarding the authorized use of an exemplary spreadsheet would not be disclosure sufficient to render obvious, “verifying a subscription status for access to the protocol.” Lastly, to reject a number of other features recited in claim 23, the Examiner has employed Official Notice. In accordance with § 2144.03 of the M.P.E.P., Applicants hereby seasonably traverse the Examiner’s use of Official Notice.

Based on the foregoing, Applicants respectfully assert that independent claim 23 and its respective dependent claims 24-28 are patentable over the presented references. Reconsideration and allowance are respectfully requested.

Additionally, Applicants note that the Examiner contends a number of the features recited in the dependent claims would have been "obvious" without presenting references to support these statements. In essence, the Examiner has employed Official Notice to support these rejections. Applicants, in accordance with M.P.E.P. §2144.03, traverse and object to the Examiner's use of Office Notice within claims 24-28. Therefore, claims 24-28 are patentable not only for their dependence to an allowable base claim but also by virtue of the additional features recited therein.

Independent Claim 41 and the Claims Depending Therefrom

As stated above, claim 41 has been amended to recite, "verifying a subscription status for access to the protocol." Applicants respectfully assert that this feature is not taught by Wood et al. Moreover, Applicants respectfully assert even if the Wyman reference is combined with the Wood et al. reference, the instant recited feature is not reached. As stated above, a licensing check regarding the usability of an exemplary spreadsheet is not disclosure sufficient to render obvious, "verifying a subscription status access to the protocol," Lastly, to reject a number of other features recited in claim 41, the Examiner has employed Official Notice. In accordance with § 2144.03 of the M.P.E.P., Applicants hereby seasonably traverse the Examiner's use of Official Notice.

Based on the foregoing, Applicants respectfully assert that independent claim 41 and its respective dependent claims 42-45 are patentable over the cited references. Reconsideration and allowance are respectfully requested.

Additionally, Applicants note that the Examiner contends a number of the features recited in these dependent claims would have been "obvious" without presenting

references to support these statements. In essence, the Examiner has employed Official Notice to support these rejections. Thus, Applicants, in accordance with M.P.E.P. § 2144.03, traverse and object to the Examiner's use of Office Notice within claims 42-45. Therefore, claims 42-45 are patentable not only for their dependence to an allowable base claim but also by virtue of the additional features recited therein.

Independent Claim 51 and the Claims Depending Therefrom

As stated above, claim 51 has been amended to recite, "verifying a subscription status for access to the protocol." Applicants respectfully assert that this feature is not recited in the Wood et al. reference. Moreover, Applicants respectfully assert even if the Wyman reference could be combined with the Wood et al. reference, the instant recited feature is not reached. As stated above, a licensing check regarding the usability of an exemplary spreadsheet is simply not sufficient to render obvious, "verifying a subscription status for access to the protocol,". Lastly, to reject a number of other features recited in the claim, the Examiner has employed Official Notice. Thus, in accordance with § 2144.03 of the M.P.E.P., Applicants hereby seasonably traverse the Examiner's use of Official Notice.

Based on the foregoing, Applicants respectfully assert that independent claim 51 and its respective dependent claims 52-58 are patentable over the cited references. Reconsideration and allowance are respectfully requested.


Additionally, Applicants note that the Examiner contends a number of the features recited in the dependent claims would have been "obvious" without presenting references to support these statements. In essence, the Examiner has employed Official Notice to support these rejections. Thus, Applicants, in accordance with M.P.E.P. §2144.03, traverse and object to the Examiner's use of Office Notice within claims 52-58. Therefore, claims 52-58 are patentable not only for their dependence to an allowable base claim but also by virtue of the additional features recited therein.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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Pg
Patrick S. Yoder
Reg. No. 37,479
Fletcher, Yoder & Van Someren
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545